

REMARKS

All the claims are rejected as allegedly anticipated by US '965.

Applicants respectfully disagree with the rejections. All the claims recite that the sealing material "is selected from the group consisting of a glass, a glass ceramic, or a ceramic."

The Office Action alleges that the sealing material taught in US '965 also consist of ceramic because both of its components, i.e., the ceramic formed from the sealing paste and the alumina are ceramic materials. See the paragraph spanning the Office Action's pages 3 and 4.

US '965 teaches on column 3, lines 17-40, that

The ceramic filler material includes two components, namely a ceramic sealing material (preferably in powder form) having a melting temperature below the melting temperature of the ceramic substrate, and a ceramic stabilizing material (also preferably in powder form) having a melting temperature higher than that of the ceramic sealing material. ...

The method of using the paste to seal holes in the ceramic substrates comprises ... raising the temperature of the ceramic substrate to a sealing temperature sufficient to melt the ceramic sealing material, but lower than the melting temperature of the ceramic stabilizing material; maintaining the ceramic substrate at the sealing temperature for a time period sufficient to allow the molten ceramic sealing material to fill interstices in the hole; and cooling the substrate. (Emphasis added.)

It is clear that the sealing material of US '965 contains two distinct ceramic materials in the final seal, i.e., one originating from the ceramic sealing material which melts, and the other originating from the ceramic stabilizing material which does not melt, but was suspended, e.g., in powder form, in the ceramic filler material. Thus, the final seal has distinct particles of the ceramic stabilizing material surrounded by the ceramic sealing material which melted during the above discussed processing. As such, the ceramic seal of US '965 does not consist of "a ceramic." (Emphasis added.)

Relevant to the situation here are the holdings of *Norian Corp. v. Stryker Corp.*, 77 USPQ2d 1242 (Fed. Cir. 2005) and *Abbott Laboratories v. Baxter Pharmaceutical Products Inc.*, 67 USPQ2d 1191 (Fed. Cir. 2003) regarding the proper interpretation to give to the scope of members of a Markush group, i.e., both holding that the claims include members of a Markush group singly, and not a mixture thereof.

In *Norian v. Stryker* the court held that the claims reciting a “solution consisting of water and a sodium phosphate” included “only a single solute,” i.e., “a single sodium phosphate” and excluded a mixture of different phosphates in a single solution. The court held that “the word ‘a’ [is interpreted] in its singular sense when ... it has been used in conjunction with the closed transitional phrase ‘consisting of.’”

The court in *Abbott v. Baxter* focused on the plain meaning of the Markush language of the claims reciting “a” with “consisting of,” and held that such a combination indicates that “only one member of the Markush group” is meant by the claims, i.e., “members of the Markush group are used singly.” (Emphasis added) The court also noted in *Abbott v. Baxter* that “if a patentee desires mixtures or combinations of the members of the Markush group, the patentee would need to add qualifying language while drafting the claim.”

The claims of the present application by their plain meaning exclude multiple members of the recited groups or mixtures thereof in any combination, e.g., mixtures of a glass with a ceramic are excluded and so are mixtures of a ceramic with another different ceramic.

Support for the claim amendments can be found, for example, on page 3, lines 16 to 18 of the specification discloses that “... the sealing element can also consist of a brittle-fracture material, especially glass, glass ceramic or ceramic.”

Reconsideration is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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